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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: David A. Jones et al.

Appln. No.: 09/898,341

Filed: July 3, 2001

For: Soft Highly Absorbent Paper Product
Containing Ketene Dimer Sizing Agents

Examiner: Peter Chin

Art Unit: 1731

Attorney Docket No: 659/866 (KC Ref. No. 13,308.1)

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TRANSMITTAL

Sir:

Attached is/are:

- ☒ Appellants' Reply Brief (in trip.)
- ☒ Return Receipt Postcard

Fee calculation:

- ☐ No additional fee is required.
- ☐ Small Entity.
- ☐ An extension fee in an amount of \$_____ for a _____-month extension of time under 37 C.F.R. § 1.136(a).
- ☐ A petition or processing fee in an amount of \$_____ under 37 C.F.R. § 1.17(_____).
- ☐ An additional filing fee has been calculated as shown below:

					Small Entity			Not a Small Entity	
	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	or	Rate	Add'l Fee
Total		Minus			x \$25=			x \$50=	
Indep.		Minus			X100=			x \$200=	
First Presentation of Multiple Dep. Claim					+\$180=			+ \$360=	
					Total	\$		Total	\$

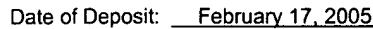
Fee payment:

- ☐ A check in the amount of \$_____ is enclosed.
- ☐ Please charge Deposit Account No. 23-1925 in the amount of \$_____. A copy of this Transmittal is enclosed for this purpose.
- ☐ Payment by credit card in the amount of \$_____ (Form PTO-2038 is attached).
- ☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

Amanda M. Church
Amanda M. Church (Reg. No. 52,469)

February 17, 2005
Date



This is a reply to the Examiner's Answer, dated December 17, 2004. Appellants initially filed an Appellants' Brief on March 17, 2003, as an appeal from the Final Office Action ("Final Action", July 17, 2002, Paper No. 6). The Examiner responded to Appellants' Brief by issuing an Office Action ("Response to Brief", June 5, 2003, Paper No. 9).

In the Response to Brief, the Examiner withdrew the finality of the Final Action. Appellants then filed a Supplemental Brief in response to the Response to Brief, which was accompanied by a Request for Reinstatement of the Appeal, pursuant to 37 C.F.R. 1.193(b) (2) (ii). Appellants' Brief, filed March 17, 2003, was thereby incorporated by reference in its entirety (see MPEP § 1208.02). The Examiner's Answer was filed in response to Appellants' Supplemental Brief.

I. Grouping of Claims

In the Examiner's Answer, the Examiner asserts that Appellants do not give any reasons as to why the claims do not stand or fall together. Appellants respectfully disagree. Appellants' reasoning was providing in the Appeal Brief (p. 4-5) and the Supplemental Appeal Brief (p.6-7). Moreover, in view of the recent amendments to the patent rules, § 41.37(a)(vii), the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. For this reason, arguments regarding the grouping of claims may be rendered moot.

However, Appellants believe that Claims 1, 4-17 and 21-22 are distinct from Claims 2-3, and both of these groups are distinct from Claims 18-20. The first group, including Claims 1, 4-17 and 21-22 recite an absorbent sheet of product that includes both a surface active agent and a ketene dimer sizing agent. The second group, including Claims 2-3, recites an absorbent sheet including at least about 1 pound of a ketene dimer sizing agent per ton of paper product, where the paper product has an absorbency rate of less than about 10 seconds. The third group, including Claims 18-20, recites a method of making an absorbent sheet product including combining a ketene dimer sizing agent with paper making fibers and combining a surface active agent with paper making fibers.

The first and second groups are separately patentable as subcombinations usable together (MPEP 806.05(d)). A sheet or product including both a surface active agent and a ketene dimer sizing agent may be used in applications where an absorbency rate greater than about 10 seconds is permissible. The first and second groups are each separately patentable relative to the third group as process of making and product made (MPEP 806.05(f)). A sheet or product including a surface active

agent and a ketene dimer sizing agent can be made by a materially different process, such as by applying a liquid containing a ketene dimer sizing agent and/or a surface active agent to a preformed sheet or product and evaporating the liquid.

II. Claims 1-22 are not obvious under 35 USC § 103

The claims at issue stand rejected as obvious over Voigtman and Donnelly in view of Osberg, the admitted state of prior art from Appellants' specification, and Ampulski or Wendt. As conceded by the Examiner, both Voigtman and Donnelly are "silent as to the joint use of a surfactant with ketene dimer" (Response to Brief, p. 3). The Examiner attempts to use the four other references to infer the missing teaching of the joint use of a surfactant with a ketene dimer.

The Appellants respectfully disagree with the Examiner's characterization of all of these references, and point out that the Examiner's inferences are in opposition to the plain meaning of the references. The Examiner maintains that the rejection is based on the fact that ketene dimer is hydrophobic and reduces the wettability of paper and that one of ordinary skill in the art would look to well known prior art solutions to offset this effect when making absorbent tissue paper (Response to Supplemental Brief, p.6). None of the references teach or suggest the Examiner's supposition. As addressed in Appellant's Supplemental Brief, such a conclusory statement is no more than a classic hindsight reconstruction of the references using Appellant's specification as a guide (MPEP 2144.06).

The Examiner has failed to present a *prima facie* case of obviousness over Voigtman or Donnelly in view of any of the above mentioned references. The Examiner fails to point to any teaching of record that would suggest combining any of these references. Moreover, the combination of the references, even if proper, fails to teach or suggest each and every element of the claims. Accordingly, Appellants' claims are not obvious under 35 USC § 103 over Voigtman, Donnelly, Osberg, the teachings of the Appellants' specification, Ampulski, or Wendt alone or in combination.

III. Claims 18-20 should not be subject to an obviousness-type double patenting rejection

Claims 18-20 stand rejected under the judicially created doctrine of obviousness-type double patenting as being obvious over Claims 1-10 of U.S. Patent No. 6,027,611 to McFarland ("McFarland"). The Examiner asserts that because the claims are open to using a multi-suspension headbox for making the absorbent paper, they are not patentably distinct from McFarland.

The Examiner has not presented a prima facie case of obviousness for Claims 18-20 relative to Claims 1-10 of McFarland. An obviousness-type double patenting determination parallels the determination for obviousness under 35 U.S.C. § 103(a) in view of a reference (MPEP § 804, section II B 1.). Accordingly, the claims of the asserted patent must include a teaching or suggestion of each and every element of the claims (MPEP 2143). McFarland does not teach or suggest the use of a surface active agent, as do Claims 18-20. Because each and every element of the claims is not taught or suggested by McFarland, they cannot be subject to an obviousness-type double patenting rejection.

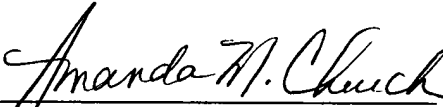
IV. Claims 18-20 are not indefinite under 35 U.S.C. § 112, second paragraph.

The Examiner fails to address this argument made by Appellants in their Supplemental Brief. Because the grounds of rejection not argued in the examiner's answer are usually treated as having been dropped, MPEP § 1208, Appellants request that this ground for rejection be dismissed from the Appeal.

V. Conclusion

The cited references, either alone or in combination, do not provide a valid basis for a *prima facie* obviousness rejection of the present claims. Also, Claims 18-20 are not invalid for failing to point out and particularly claim what Appellants regard as their invention. Accordingly, Appellants submit that the present invention is fully patentable over Voigtman or Donnelly, alone or in combination with Ampulski, Osberg, Appellants' own specification, Wendt, or McFarland, and the Examiner's rejection should be REVERSED.

Respectfully submitted,


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